

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 10/520,463

IN THE DRAWINGS:

Applicant encloses replacement drawing sheets 1/8, 2/8 and 3/8 in which the reference characters 4c and 4b have been deleted from Figs. 1, 2 and 3.

Attachments: Replacement sheets 1/8, 2/8 and 3/8

REMARKS

Election/Restrictions

Applicant cancels, without prejudice, claims 20-37 and replaces them with new claims 38-55 of which at least claims 38-45, 50, 51 and 54 are readable on the elected species (Fig. 1), with at least new claim 38 being generic.

Information Disclosure Statement

Apparently, the International Office (WIPO) did not forward to the USPTO copies of the International Search Report references. Therefore, Applicant encloses copies of the ISR references which are not U.S. patents or U.S. patent publications, and requests the Examiner to return an initialed copy of the already submitted Form PTO/SB/08 A & B.

Drawings

Applicant encloses replacement drawing sheets 1/8, 2/8 and 3/8 in which the reference characters 4c and 4b have been deleted.

Claim Rejections - 35 U.S.C. § 112

Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph, insofar as it may be applied to the new claims 38-55 which have been drafted to correct/overcome each and every one of the Examiner's stated grounds of allegedly indefinite claim language.

Claim Rejections - 35 U.S.C. § 102 and §103

Applicant respectfully **traverses** the rejections under 35 U.S.C. § 102(b) based on anticipation by Komasara '693 and Roberts '078, and under 103(a) based on patentability (obviousness) over Roberts in view of Komasara, or Roberts in view of Huberty '532, for the following reasons.

First, the rejections under 35 U.S.C. § 102(b) require that Komasara and Roberts disclose, either expressly or inherently, each limitation of each of the rejected claims, or in other words, that each of the rejected claims be readable on the disclosure of either Komasara or Roberts. Applicant respectfully submits that clearly such is **not** the case here.

With respect to the rejections under 35 U.S.C. § 103(a), such a rejection requires that the applied references teach, or at least suggest, **all limitations** of each of the rejected claims. Again, Applicant respectfully submits that clearly such is **not** the case here.

To overcome the Examiner's assertion that the binder is not part of the construction element, the new claims 38-45 are directed to "a wall".

More specifically, the Examiner rejects **claim 20** (replaced by new claim 38) as being anticipated by Komasara et al. (US 6,240,693). Applicant, however, does not share the Examiner's point of view. Komasara et al. relates to a pattern assembly (see title, column 4, lines 60 and claim 1) which is not a construction element. The Examiner confuses a construction element and a pattern assembly in order to argue a lack of novelty (anticipation) of the present invention. The pattern assembly according to Komasara et al. is provided for use in assembling a

wall structure for receiving a poured concrete (column 4, lines 63-64). Therefore, the pattern assembly has to be considered as a kind of a mold, and not as a construction element made of concrete. Moreover, the pattern assembly of Komasara et al. is made of plastic or expanded polystyrene material (see column 5, lines 8-10).

Although the pattern assembly of Komasara et al. has a groove or mortise and a protuberance or tenon, they do not have the same function and are applied differently than the one in the construction element according to Applicant's claimed invention. As is shown in Figure 2, the interlocking means of Komasara et al. are equipped with tongue (32) and groove (36) portions and permit a plurality of form structures to be assembled according to a desired stacking arrangement (see column 5, lines 41-44). According to Komasara et al. there is thus no binder in the groove since the concrete is poured in the concrete filling passageways 26 (see column 5, lines 27-28 and column 6, lines 60-61). Therefore, the interlocking means of Komasara are only for assembling the pattern assembly by fitting the tongue into the groove. After assembling, the concrete is poured into the concrete filling passageways 26.

Contrary to Komasara et al., in the present invention the construction element is made of concrete, and a binder is poured in the grooves so that a strip of binder is formed between the groove and the protuberance. In Komasara et al., there is not such a strip of binder since concrete is poured in the concrete filling passageways where no interlocking means are present.

Thus, **contrary** to what is said by the Examiner, the groove 36 of Komasara et al. is not capable to have the application by grading a binder needed for the assembly of the construction elements to one another. Moreover, and also **contrary** to the Examiner's opinion, the mortise of

Komasara et al. is not associated with a load-bearing wall, as there is no load-bearing wall in the pattern assembly of Komasara et al..

The Examiner is of the opinion that all the limitations regarding the binder have "little patentable weight" as the binder relates to an intended use with a construction element "as recited".

The new claims 38-40 are directed to a "wall" so as to give patentable weight to the binder. The binder is needed to explain how the groove and protuberance of the present invention are dimensioned. Indeed, in the present invention the adjustment of the alignment, height and plumb of the assembled construction element is provided by the dimension of the protuberance and the groove and the amount of binder poured in the groove.

As no binder is present in the interlocking elements of Komasara et al., not only the features of such alignment provided by the present invention are **novel** in view of Komasara et al., but they are also **nonobvious**. The teaching of Komasara et al. is to use the interlocking means for the sole purpose of interlocking. There is no teaching or suggestion in Komasara et al. to provide any alignment function by using the interlocking means and a binder therein.

The observation of the Examiner that the "distance of mortise [in Komasara et al.] is arranged from the outer lateral edge of the construction element, which is sufficient to prevent the overflow of binder beyond the edge of the element during assembly" is pure hindsight. When the pattern assemblies of Komasara et al. are associated, the mortise is completely engaged in the groove, and it does not come into contact with a binder as the concrete is poured in the elongated concrete filling passageways.

The observation made by the Examiner with respect to (canceled) claim 22, now claim 44, also has to be qualified as hindsight. Indeed, there is no question of a tolerance in the pattern assembly of Komasara et al., and so there cannot be a tolerance inherently proportional to the depth of the mortise and height of the tenon.

The same applies to the observation made with respect to canceled claim 23, now claim 40. Moreover, as the pattern assemblies of Komasara et al. are made of plastic or expanded polystyrene, they are of light weight, and there is no relationship with the fluidity of the binder. Such a relationship would also make no sense, as there is no binder in the interlocking means of Komasara et al.

With respect to (canceled) claim 24, now claim 45, it should be observed that in Komasara et al. the pattern assemblies have no load-bearing wall. Therefore, the width of the mortise cannot be less than the thickness of the load-bearing wall as the examiner pretends.

With respect to (canceled) claim 35, now claim 53, it should be noted that according to Komasara et al. the wall is made of concrete and not of construction elements, and so the comparison made by the Examiner does not apply.

The Examiner also rejects (canceled) claims 20-23, 29 and 35-36 as being anticipated by Roberts (US 822,078). According to the drawing made by the Examiner, the reference B, respectively A, is allocated to the upper, respectively the lower face. This is, however, not compatible with the drawings presented in the Roberts patent. As can be seen in Figure 1 of Roberts, the faces A and B are lateral faces and not the lower and upper face! Consequently, the

groove or mortise 4 is not on the upper face but, rather, on the lateral face, and the protuberance or tenon 3 is not on the lower face but on the other lateral face.

The assumption of the Examiner is also contrary to the description of Roberts. On page 1, lines 47-53 of Roberts there is mentioned that the tongue and groove are vertically arranged and have a transverse dimension. The latter could not be applicable if they were applied on the upper and lower face.

Moreover, Roberts' mortise is, **contrary** to what the Examiner describes, not associated with a load-bearing wall G. In the Examiner's figure, G is the upper face of Roberts' block, and the mortise is not associated therewith as it is applied on face B. The Examiner contradicts him/herself since on the one hand he/she asserts that mortise 4 extends on the upper face B, and on the other hand it is associated with wall G. The mortise should thus consequently be on two faces which is not possible!

In Roberts, there is also no binder between the mortise and the tenon as is the case in the present invention. So, there can be no alignment using the binder, the mortise and the tenon as in the present invention. This invention is thus new in view of Roberts. As there is no teaching in Roberts to use the tenon, mortise and binder for alignment purposes, the present invention is also novel and nonobvious over Roberts. In this context it should also be noted that Roberts (see page 1, lines 58-59) teaches a close sliding fit between tongue and groove, which even leads the skilled person away from applying a binder at this location.

With respect to (canceled) claim 22, now claim 44, Roberts does not teach any tolerance. On the contrary a close sliding fit should be present. Consequently, the examiner applies hindsight to read a tolerance according to the present invention in Roberts.

There is no question of any relation between the ratio of the construction element's weight and the fluidity of the binder. So, contrary to the Examiner's opinion, this can never anticipate claim 23, now claim 40.

The Examiner also combines Roberts and Komasara et al. to argue obviousness. Roberts and Komasara et al. can be combined only by using an ex post facto (hindsight) analysis as does the Examiner. In fact, both techniques are simply incompatible! Roberts deals with cement building blocks (see page 1, lines 6-7) whereas Komasara et al. deal with plastic or expanded polystyrene pattern assemblies. How can a cement building block be combined with a plastic or expanded polystyrene material? The skilled person would not even conceive to combine both teachings, as they are simply incompatible.

Applying a mortise having a width less than the thickness of the load-bearing wall in Roberts, as argued by the Examiner, would never be considered by the skilled person as there is no association in Roberts between the load-bearing wall and the mortise. This argument can, thus, not be used for arguing obviousness. Moreover, the skilled person would certainly not do this for preventing an overflow of binder, as there is no binder in the groove of Roberts !

With respect to (canceled) claim 28, now claim 47, the Examiner is contradictory when mentioning that Roberts fails to disclose a mortise being arranged above each load-bearing wall. The Examiner already asserted with respect to claim 20 that the mortise is associated with a load-

bearing wall. As such an association implies that the mortise is above the load-bearing wall, there is clearly a contradiction in the Examiner's arguments. As, moreover, in Komasara et al. the mortise is also not above the load-bearing wall, a combination of both references can never lead to Applicant's claimed invention.

The Examiner is further of the opinion that (canceled) claims 26 and 27, now claim 54, are unpatentable over Roberts and Huberty (US 2002/0038532). For this purpose, the Examiner mentions that Roberts discloses that the height of the element is greater than or equal to its length. Considering Figure 1 of Roberts, this is simply not correct! The elements of Roberts have a length which is much longer than the height. As the starting point of the Examiner's assumption is not correct, all the rest also is incorrect!

In view of the above amendments and Remarks, Applicant respectfully requests the Examiner to reconsider and withdraw all objections, requirements and rejections, and to find the application now to be in condition for allowance with all of **claims 38-55**; that is, since the generic claim 38 now should be allowable, all claims directed to the non-elected species also now should be examined in the present application.

Applicant files concurrently herewith a Petition (with fee) for an Extension of Time of two months. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 10/520,463

additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in
the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

/John H. Mion/
John H. Mion
Registration No. 18,879

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
(202) 663-7901

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: May 17, 2007